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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,402	08/22/2003	Martin Kiesel	1140668-0015 CON	9503
7470	7590	05/13/2005	EXAMINER	
WHITE & CASE LLP PATENT DEPARTMENT 1155 AVENUE OF THE AMERICAS NEW YORK, NY 10036			CABRERA, ZOILA E	
			ART UNIT	PAPER NUMBER
			2125	

DATE MAILED: 05/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.	KIESEL ET AL	
10/646,402	KIESEL ET AL	
Examiner Zoila E. Cabrera	Art Unit 2125	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) Responsive to communication(s) filed on 22 August 2003.  
2a) This action is FINAL.                    2b) This action is non-final.  
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) Claim(s) 1-25 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) Claim(s) \_\_\_\_\_ is/are allowed.  
6) Claim(s) 1-25 is/are rejected.  
7) Claim(s) \_\_\_\_\_ is/are objected to.  
8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) The specification is objected to by the Examiner.  
10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_  
5) Notice of Informal Patent Application (PTO-152)  
6) Other: \_\_\_\_\_

## DETAILED ACTION

### ***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-25 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of copending Application No. 10/226,979. Although the conflicting claims are not identical, they are not patentably distinct from each other because the organizational elements and their functionality are merely obvious variations of each other. It would have been

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obvious to a person of the ordinary skill in the art at the time the invention was made to refer to "a plurality of movements", claim 1 of the instant application, instead of "certain movements", claim 1 of 10/226,979. Renaming like features merely produces the same sought after results.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The metes and bounds of claim 25 cannot be readily determined. It is not clear whether all the steps or some steps of claim 17 are included in claim 25. Applicant is suggested to rewrite the claim in independent form to properly and clearly recite each step.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-13, 15-22, 24-25 are rejected under 35 U.S.C. 102(b) as being anticipated by **Haseley et al. (US 5,602,757)**.

**Haseley** discloses an electronic fingerprint apparatus for a machine, comprising:

- an automation component comprising a controller for controlling movements of at least one component of the machine (Col. 5, lines 17-26, i.e., action commands may be generated by the microcontroller to a monitored machine), the automation component adapted for capturing electronic fingerprints representative of a state of the machine (Col. 5, lines 4-9; Col. 7, lines 14-17 and lines 23-28, i.e., vibration signatures are generated from collected vibration data).

Please note that "signature" or "footprint" are measurements in a machine that are characteristic of and document the behavior, or vibration, of the machine, which is the definition of "electronic fingerprints" in Specification, Page 1 of the present invention; see also Col. 1, lines 17-20); and a fingerprint device for selecting for measurement a plurality of movements of the machine to generate an electronic fingerprint that is representative of a condition of the machine (Col. 3, lines 22-26, i.e., sensor to measure vibration; Col. 5, lines 22-30, i.e., each sensor provides vibration data to produce vibration signatures which are used to monitor fault conditions of the machine).

As for claims 2-6, **Haseley** discloses,

- the automation component is selected from the group consisting of a numeric control, a motion controller, a programmable logic controller or an intelligent drive (Col. 4, lines 11-15, i.e. vibration monitoring system);
- the automation component and the corresponding engineering system provide a program platform/environment for the implementation of electronic fingerprints by an application engineer (Col. 6, lines 57-61; Col. 6, lines 8-19);
- an engineering system corresponding to the automation component, wherein implementation of the fingerprints is done by at least one of a configuration process in the engineering system and a programming process using a specific API for the implementation of fingerprints (Col. 7, lines 13-16; Col. 4, lines 65-67);
- the start of capturing the fingerprints is done by an action selected from the group consisting of starting by local user via local HMI and starting by remote user via Ethernet/Internet; and starting based on an event evaluated in an application program running in the automation component (Col. 7, lines 13-16; Col. 6, lines 7-19 and lines 33-40);
- the apparatus is used for a machine selected from the group consisting of machine tools, packaging machines, a rubber-working machines; plastic-working machines; printing presses; woodworking machines; glassmaking machines; ceramic-working machines; stoneworking machines; textile machines; robotic manufacturing machines and material handling machines (Col. 3, lines 10-17).

As for claims 7 and 18, **Haseley discloses,**

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- the fingerprint device and the automation component generate an electronic fingerprint that is generic to a type of machine tool that indicates a stable behavior of the machine tool (Col. 6, lines 50-53 and lines 22-28).

As for claims 8 and 19,

- the fingerprint device and the automation component generates an electronic fingerprint having a deviation from the stable behavior, thereby indicating an unstable behavior of the machine (Col. 6, lines 29-32 and lines 54-56; Col. 5, lines 22-30).

As for claims 9 and 20,

- the fingerprint device and the automation component generates a specific fingerprint of a particular production machine that is representative of a state of at least one the outputs of the particular production machine and the stable behavior of the machine (Col. 6, lines 22-28 and lines 50-53).

As for claims 10 and 21,

- a graphical user interface for displaying a graphical depiction of the electronic fingerprint (Col. 5, lines 1-4).

As for claims 11,

- the fingerprint device is adapted for generating a periodic electronic fingerprint that is developed from a snap shot of the state of the machine at a certain time (Col. 6, lines 57-58, i.e., vibration data is collected at user selected time intervals).

As for claims 12 and 22,

- an application for comparing the electronic fingerprints over time (Col. 7, lines 23-28 and lines 35-40).

As for claims 13 and 25,

- a memory for storing the electronic fingerprints as a database (Col. 7, lines 23-28, data memory 38).

As for claims 15 and 24,

- a remote communication capability that couples the machine to a remote processor (Col. 4, lines 28-37).

As for claim 16,

- the electronic fingerprint is downloaded over the remote communication to the remote processor (Col. 4, lines 28-37, i.e., communication between a remote field monitor and the vibration monitoring system would allow transfer of vibration data).

As for claim 17, **Haseley** discloses a method for generating electronic fingerprints for measuring a state of a machine, the method comprising the steps of:

- selecting for measurement parameters associated with at least one-component of the machine (Col. 4, lines 59-65; Fig. 2, footprint or signature with parameters being frequency and velocity; Col. 5, lines 22-28; Col. 3, lines 24-26, sensors may be accelerometers or any other type of sensors used to measure vibration), that are representative of a condition of the machine (Col. 3, lines 22-26, i.e., sensor to measure vibration; Col. 5, lines 22-30, i.e., each sensor provides vibration data to produce vibration signatures which are used to monitor fault

conditions of the machine); reading the parameters; and storing the read parameters (Col. 6, lines 65-67), thereby creating an electronic fingerprint representative of a condition of the machine (Col. 7, lines 13-16 and lines 22-28 and lines 35-40).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Haseley et al. (US 5,602,757)** in view of **Hays et al. (US 6,330,525)**.

Regarding claims 14 and 23, **Haseley** discloses the limitations of claims 1 and 17 above but fails to disclose the limitations of claims 14 and 23. However, **Hays** discloses such limitations as follows:

- a maintenance scheduler for scheduling maintenance of the machine based on a prediction of a failure of the machine based on the electronic fingerprint (Col. 10, lines 48-56; Col. 20, lines 13-22; Col. 6, lines 20-35, i.e., performance signatures).

Therefore, it would have been obvious to a person of the ordinary skill in the art at the time the invention was made to combine the vibration monitoring system of **Haseley** with the diagnosing system of **Hays** because it would provide an improved system

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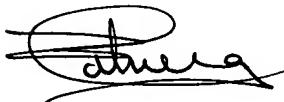
wherein data may be used to provide maintenance and continuous monitoring of machine health (Col. 6, lines 16-35).

***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning communication or earlier communication from the examiner should be directed to Zoila Cabrera, whose telephone number is (571) 272-3738. The examiner can normally be reached on M-F from 8:00 a.m. to 5:30 p.m. EST (every other Friday).

If attempts to reach the examiner by phone fail, the examiner's supervisor, Leo Picard, can be reached on (571) 272-3749. Additionally, the fax phones for Art Unit 2125 are (703) 872-9306. Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist at (703) 305-9600.



Zoila Cabrera  
Patent Examiner  
5/12/05